

### REMARKS

Claims 1-26 are pending in the present application. In the Decision on Appeal of May 9, 2006, the Board affirmed the Examiner's rejection of claims 18-26 under 35 U.S.C. § 101, reversed the rejection of claims 11-14, 16, and 17 under 35 U.S.C. § 112, reversed the rejection of claims 1-3, 6, 7, 23, 24, and 26 under 35 U.S.C. § 102, and reversed the rejection of claims 4, 5, 8-22, and 25 under 35 U.S.C. § 103.

Appellant respectfully requests reconsideration by the Board of the rejection of claims 23-26 under 35 U.S.C. § 101. In regard to claims 23-26, the Board stated that the claims are unpatentable since they are "directed to a 'computer data signal embodied in a carrier wave' and the steps are just statements of capability," and that "[s]ignals' not embodied in a tangible medium" are non-statutory. Decision, May 9, 2006, p. 7. Appellant believes that the Board has improperly interpreted claim 23 and that the reasons for rejection stated herein above ignore specific guidelines set forth in the MPEP and prior case law. Appellant believes that claim 23, and the claims dependent therefrom, are clearly directed to statutory subject matter and should be in condition for allowance.

Claim 23 calls for "[a] computer data signal embodied in a carrier wave and representing a set of instructions which, when executed by at least one processor, causes the at least one processor to enable an option in a device." Under MPEP §2106(IV)(B)(1)(c) "a signal claim directed to a practical application of electromagnetic energy is statutory regardless of its transitory nature." Citing O'Reilly v. Morse, 56 U.S. (15 How.) 62, 114-19 (1853); In re Breslow, 616 F.2d 516, 519-21, 205 USPQ 221, 225-26 (CCPA 1980). The Board disregards this section of the MPEP by stating that "[s]ignals' not embodied in a tangible medium" are non-statutory. Decision, supra at 7. As previously argued by the Appellant, the fact that the carrier wave of claim 23 "is not a computer readable medium as it is not persistent" is irrelevant to patentability under §101 as explained in MPEP §2106(IV)(B)(1)(c). See Office Action, June 15, 2004, pg. 3; see also Supplemental Appeal Brief, September 15, 2004, p. 5. Simply, claim 23 is patentable under §101 because, as stated in MPEP §2106(IV)(B)(1)(c), it calls for a signal directed to a practical application of electromagnetic energy that "causes the at

least one processor to enable an option in a device.” Accordingly, claim 23, and the claims dependent therefrom are in compliance with §101.

Applicant’s independent claim 23 is directed to patentable subject matter. The Board’s contention that “[s]ignals” not embodied in a tangible medium” are non-statutory, is incorrect and improperly applied here. In this regard, it is instructive to observe the following representative issued patent claims, including very recently issued patent claims directed to a computer data signal. Appellant is not submitting these illustrative claims as new arguments, but rather as examples which the Board should consider in determining the patentability of claim 23.

USP 7,024,655 to Cobb April 4, 2006

11. A computer data signal embodied in an electromagnetic waveform, comprising:

a source code segment for processing features in design data to determine if ruled-based optical proximity correction or model-based optical proximity correction should be used for a particular feature;

a source code segment for selecting a particular model from a set of models for correcting a said particular feature to be corrected with said model-based optical proximity correction system;

a source code segment for selectively correcting each feature to be corrected with said ruled-based optical proximity correction or said model-based optical proximity correction; and

a source code segment for outputting corrected design data.

USP 7,024,387 Nieboer et al. April 4, 2006

9. A computer data signal embodied in a carrier wave having a plurality of source code segments comprising:

a segment for processing data from a variable number of trader terminals for entering an order for an item in the form of an algorithm with constraints thereon that represent a willingness to transact, whom dynamically changing price is a dependent variable of the algorithm within the constraints and price of another item is an independent variable, the price as the dependent variable being continuously changeable responsive to changes in price of the independent variable, the algorithm representing a buy or sell order, and

a segment for a controlling a computer coupled to each of the trader terminals over a communications network and receiving as inputs,

a) each algorithm with its corresponding constraints and

b) an external price feed depicting prices of various items and contracts from external multiple data sources which may be used as an independent variable of the algorithm or an input to a constraint variable, the sources code further comprising,

a segment for matching or comparing, in accordance with the constraints and conditions, algorithmic buy/sell orders with algorithmic or non-algorithmic sell/buy orders through the use of the external multiple data sources, and

a segment for simultaneously executing a trade of said items in the same or diverse equity markets as a single electronically matched trade.

USP 7,017,109 to Douvikas et al. March 21, 2006

25. A computer data signal embodied in a carrier wave, comprising computer instructions for:

- providing an electronic business card Web site to a user;
- allowing the creation of an electronic business card by the user using said Web site, said creation comprising:
  - allowing the user to enter information into a plurality of fields;
  - storing said information; and
  - sending an authentication email to the user, wherein a reply to said authentication email is required to complete said creation;
- allowing the user to search for one or more electronic business cards;
- allowing the user to view said electronic business cards; and
- if said creation is completed, allowing the configuring of an email application to automatically include a hyperlink to said electronic business card Web site on outgoing emails.

The above representative patent claims demonstrate, *inter alia*, the propriety of patent claims directed to a computer data signal. As stated above, Appellant's independent claim 23 recites the practical application of a computer data signal embodied in a carrier wave and thus should be considered as directed to patentable subject matter.

For the reasons stated above, and previously presented in prior responses, Appellant respectfully requests that the Board reverse the rejection of claims 23-26 under 35 U.S.C. § 101.

Respectfully submitted,

/Timothy J. Ziolkowski/

Timothy J. Ziolkowski  
Registration No. 38,368  
Direct Dial 262-376-5139  
[tjz@zpspatents.com](mailto:tjz@zpspatents.com)

Respectfully submitted,

/Kevin R. Rosin/

Kevin R. Rosin  
Registration No. 55,584  
Phone 262-376-5170 ext. 15  
[krr@zpspatents.com](mailto:krr@zpspatents.com)

Dated: July 10, 2006  
Attorney Docket No.: GEM8081.023

**P.O. ADDRESS:**  
Ziolkowski Patent Solutions Group, LLC  
14135 N. Cedarburg Rd.  
Mequon, WI 53097-1416  
262-376-5170